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EXAMINER

BLECK, CAROLYN M

ART UNIT PAPER NUMBER

3626

DATE MAILED: 08/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/653,384

Applicant(s)

SHOLEM, STEVEN L.

Examiner

Carolyn M Bleck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 39 and 42-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 39 and 42-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the amendment filed 2 June 2004. Claims 39 and 42-61 are pending. Claims 39, 43, 45, and 47-48 have been amended. Claims 1-38 and 40-41 have been cancelled.

### ***Claim Rejections - 35 USC § 112***

2. The rejections of claims 45-46 and 49 is hereby withdrawn due to the amendment filed 2 June 2004.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 39, 42-43, 45-46, 49-51, and 56-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pritchard (4,491,725) in view of Aleia et al. (5,991,733).

(A) As per claim 39, Pritchard discloses a medical claim verification and processing system:

(a) a display for displaying information stored in the terminal (Fig. 4, col. 6 lines 8-24);

(b) a memory (col. 3 lines 29-35 and col. 12 lines 43-47);

(c) a central brokerage computer storing files and tables and providing funds transfers between various parties (Fig. 1, col. 4 lines 54-64);

(1) entering an insurance policy number and name of an insurance plan (Fig. 1, 2, 3, and 5, col. 7 lines 7-36);

(2) accessing data stored system memory related to a set of service codes and the claim payment for each service code (col. 8 lines 44-63, col. 12 lines 40-68); and

(3) determining the claim payment for each service code (col. 8 lines 44-63, col. 12 lines 40-68).

Pritchard fails to expressly disclose a means for determining the value of a medical service which includes the following: accessing data "indicative of the historical payment patterns of the TPP to one or more medical service providers from which a net present value of a future payment by the TPP for the at least one medical service for a patient associate with the TPP may be generated" and generating "an indication of the NPV of the at least one medical service based at least in part upon the historical payment patterns of the TPP to the one or more medical service providers."

Aleia discloses an automated decision support (ADS) tool for utilizing historical information to predict success and dollar value outcome of a particular case and for comparing the projected outcome with the cost to proceed to guide the decision process on whether the contemplated action should be executed (col. 10 line 41 to col. 11 line

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30). Aleia discloses that in order to predict the success, the system uses a comparison of like cases stored in the system (col. 10 line 41 to col. 11 line 30). Further, Aleia discloses calculating a POV (predictive outcome value), which is the projected cost/benefit of successfully executing the prescribed strategy to the predicted outcome, wherein the POV considers internal cost, and expected external escalation costs, factors associated with the strategy, the probability of success, the recovery amount and time period (present value) to achieve the desired result so that net recovery can be calculated, wherein these calculations are based on historical information (col. 8 lines 3-28, col. 10 line 41 to col. 11 line 30). The Examiner considers Aleia's case to be a form of "medical service" and the probability of success (i.e., the likelihood the case will be paid") using like cases stored in the system to be a form of a "historical payment pattern".

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Aleia within the system of Pritchard with the motivation of providing a more accurate means for determining the cost of treating a patient by utilizing historical information to predict success and dollar value of an outcome dynamically (Aleia; col. 10 lines 60-65).

(B) As per claim 42, Pritchard discloses in Figure 6 a table showing the maximum insurance claim payment amount for various services (col. 6 lines 33-46). However, Pritchard and Aleia fail to expressly disclose a time delay in payment of fees by the TPP or a percentage of the allowable fees paid by the TPP. However, it is respectfully

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submitted that typically health care providers and insurance companies have data stored in a database regarding the percentage of allowable fees paid by the insurer and the providers also store data on when a provider is paid by the insurance company. The skilled artisan would have found it an obvious modification to the system of Pritchard and Aleia to include this data with the motivation of valuing a particular procedure, good, or service, thus ensuring profitability for the health care provider.

(C) As per claim 43, Aleia discloses calculating the present value of recovery costs and the estimated net recovery. However, Aleia does not expressly disclose the exact formula for the calculations. It is respectfully submitted that the estimated net recovery is a form of Applicant's "relative value" as Aleia's Fig. 1K appears to disclose showing the recovery costs – recovery amount would equal the net recovery (Fig. 1K). The remainder of claim 43 repeats the limitations of claim 39, and is therefore rejected for the same reasons as claim 39, and incorporated herein.

(D) As per claims 45-46, Aleia discloses presenting the present value (Fig. 1K, col. 8 lines 3-15). While Aleia does not disclose presenting color coded indicators of the NPV, the Examiner respectfully submits that presenting indicators in a user interface using colors is a well known technique in the graphical user interface arts. The motivation being to allow a user to quickly ascertain information.

(E) As per claims 49-51, Aleia discloses presenting the present value, wherein the present value is determined by utilizing historical information to predict success and dollar value of outcome, and is used in a comparison of the projected outcome with the cost to proceed to guide the decision process on whether the contemplated action should be executed (Fig. 1K, col. 8 lines 3-15, col. 10 lines 60-68). As per the recitation of "expected profitability of the TPP" and "enter into services agreement with a TPP", it is noted that the reason Aleia discloses calculating the present value is to determine whether the case is a profitable case to accept (Fig. 1K, col. 8 lines 3-15, col. 10 lines 60-68). As per the recitation of "at least one payment pattern of the TPP", note the discussion with regards to claim 39.

(F) As per claim 56, Pritchard discloses a central brokerage computer and database communicating with terminals (Fig. 10, col. 11 lines 34-65).

(G) As per claim 57, Pritchard discloses the terminal being a local entry terminal (Fig. 1, col. 4 lines 54-65).

5. Claims 47-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pritchard (4,491,725) and Aleia et al. (5,991,733) as applied to claim 39, and further in view of Javitt (5,918,208).

(A) As per claims 47-48, the teachings of Pritchard and Aleia disclosed in the rejection above are incorporated herein.

Pritchard discloses an identifier of a patient associated with a payer (Fig. 2-3).

Aleia discloses an automated decision support (ADS) tool for utilizing historical information to predict success and dollar value outcome of a particular case and for comparing the projected outcome with the cost to proceed to guide the decision process on whether the contemplated action should be executed (col. 10 line 41 to col. 11 line 30). Aleia discloses that in order to predict the success, the system uses a comparison of like cases stored in the system (col. 10 line 41 to col. 11 line 30). Further, Aleia discloses calculating a POV (predictive outcome value), which is the projected cost/benefit of successfully executing the prescribed strategy to the predicted outcome, wherein the POV considers internal cost, and expected external escalation costs, factors associated with the strategy, the probability of success, the recovery amount and time period (present value) to achieve the desired result so that net recovery can be calculated, wherein these calculations are based on historical information (col. 8 lines 3-28, col. 10 line 41 to col. 11 line 30). Aleia discloses displaying the present value (see Fig. 1K).

Pritchard and Aleia are silent as to fail to expressly disclose software configured to generate an indication of whether it would be profitable to accept the patient as a new patient.



Javitt discloses means for projecting revenue for performing medical procedures on a patient based on the rates of the payer (col. 2 line 49 to col. 3 line 29, col. 4 line 5 to col. 10 line 32).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the aforementioned features of Javitt within the system of Pritchard and Aleia with the motivation of allowing a physician to forecast revenues from a payer (Javitt; col. 1 lines 34-57).

6. Claims 52 and 59-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pritchard (4,491,725) and Aleia et al. (5,991,733) as applied to claim 39, and further in view of Evans (5,924,074).

(A) As per claim 52, the teachings of Pritchard and Aleia disclosed in the rejection above are incorporated herein.

Pritchard and Aleia fail to expressly disclose software configured to generate an indication of when a patient's appointment should be scheduled.

Evans discloses enabling a healthcare provider to schedule a patient appointment using a point and click interface by selecting an appointment data and an appointment time, and wherein the healthcare provider can review prior or future scheduled appointments by clicking on an appointment button (Figure 2, col. 5 line 29 to col. 6 line 9).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Evans within the system of Pritchard and Aleia with the motivation of quickly and efficiently capturing patient data (Evans; col. 2 lines 20-45).

(B) As per claim 59, the teachings of Pritchard and Aleia disclosed in the rejection above are incorporated herein.

Pritchard and Aleia fail to expressly disclose at least one electronic device being configured as one of a wireless access terminal and a wireless interface, and the at least one electronic device further comprising software configured to transmit to a pharmacy a prescription, billing information, and an address to which the prescription should be delivered.

Evans discloses communicating using a pen computer through a wireless transceiver (Figure 24, col. 12 line 55 to col. 13 line 56), wherein the pen computer is able to transmit a physician's prescription for medication to a hospital or pharmacy (col. 10 line 59 to col. 11 line 8).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Evans within the system of Pritchard and Aleia with the motivation of allowing a remotely located healthcare provider to communicate information to a pharmacy (Evans; col. 1 line 53 to col. 2 line 20).

As per the recitation of "billing information and an address to which the prescription should be delivered", it is respectfully submitted that any pharmacy would

require billing information, for example a patient's insurance information, and the patient's address to be included in a prescription submitted by a physician.

(C) As per claim 60, the teachings of Pritchard and Aleia disclosed in the rejection above are incorporated herein.

Pritchard and Aleia fail to expressly disclose software configured to evaluate a use pattern of at least one supply of a medical services provider, evaluate an inventory quantity of at least one supply, evaluate an estimated scheduled appointment use of the at least one supply, and automatically order an appropriate quantity of the at least one supply.

Evans discloses an electronic medical records system providing the capability to analyze utilization of physicians, nurses, staff, and equipment as well as time utilization for patients, such as wait times for referrals, lab results, and physician's examinations (col. 14 line 42 to col. 15 line 7).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Evans within the system of Pritchard and Aleia with the motivation of allowing a physician to have a complete audit trail of resources used in real-time (Evans; col. 2 lines 20-65).

7. Claims 44 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pritchard (4,491,725) and Aleia et al. (5,991,733) as applied to claim 39, and further in view of Official Notice.

(A) As per claim 44, Pritchard and Aleia fail to expressly disclose the cost of providing at least one medical service being a function of at least one of administrative cost of a medical services provider, an overhead cost of a medical office, a cost for medical office staff salaries, an equipment and supplies cost, and a utilities cost.

However, it is well known that in a business, setting the cost of a product or service would include within the cost calculation, calculating the administrative cost, overhead costs, and costs of staff, equipment, supplies, and utilities.

At the time the invention was made, it would have been obvious to modify the system of Pritchard and Aleia by using the cost calculation with the motivation of properly valuing the particular procedure, good, or service, thus ensuring profitability for the health care provider.

(B) As per claim 61, the teachings of Pritchard and Aleia disclosed in the rejection above are incorporated herein.

Pritchard and Aleia do not expressly disclose a biometric identifying device.

However, it is well known in the art to use biometric identifying devices.

At the time the invention was made, it would have been obvious to modify the system of Pritchard and Aleia with a biometric device with the motivation of providing a security mechanism to ensure the privacy of patient data.

8. Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pritchard (4,491,725), Aleia et al. (5,991,733), and Evans (5,924,074) as applied to claim 39, and further in view of Official Notice.

(B) As per claim 53, the teachings of Pritchard, Aleia, and Evans disclosed in the rejection above are incorporated herein.

Pritchard, Aleia, and Evans fail to expressly disclose an indication being generated as a function of at least one payment pattern of the TPP with which the patient is associated.

However, it is well known in the art that before a health care provider accepts a patient into the provider's practice, the provider examines the patient's insurance company to determine whether the practice accepts that insurance company, where accepting or denying an insurance company is based on whether the insurance company pays insurance claims efficiently.

At the time the invention was made, it would have been obvious to modify the system of Pritchard, Aleia, and Evans by using an indication with the motivation of ensuring a health care provider accepts patients where the provider is ensured they will be reimbursed for services rendered.

9. Claims 54-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pritchard (4,491,725) and Aleia et al. (5,991,733), as applied to claim 39, and further in view of Rensimer et al. (5,845,253).

(A) As per claim 54, the teachings of Pritchard and Aleia disclosed in the rejection above are incorporated herein.

Pritchard and Aleia fail to expressly disclose generating a recommended duration for a primary medical personnel to visit the patient.

Rensimer discloses using a CaPT clinical status code used by a health care provider, wherein the CPT code has an associated standard amount of time for a provider to interact with a patient (col. 4 lines 24-33).

At the time the invention was made, it would have been obvious to combine the features of Rensimer within the system of Pritchard and Aleia with the motivation of allowing a physician to better understand the allocation of professional resources used in a given practice during a particular period of time (Rensimer; col. 1 line 63 to col. 2 line 21).

(B) As per claim 55, Pritchard, Aleia, and Rensimer do not expressly disclose generating a timer indicating time remaining in the recommended duration.

However, as discussed above, Rensimer discloses using a CPT clinical status code used by a health care provider, wherein the CPT code has an associated standard amount of time for a provider to interact with a patient (col. 4 lines 24-33). It is respectfully submitted that generating a timer is a well known technique used for measuring time. The motivation being to ensure a physician is able to keep within the allocated time for an appointment of a patient.

10. Claims 58 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pritchard (4,491,725) and Aleia et al. (5,991,733) as applied to claim 39, and further in view of Joao (6,283,761).

(A) As per claim 58, the teachings of Giannini disclosed in the rejection above are incorporated herein.

Pritchard and Aleia fail to expressly disclose at least one electronic device configured as one of a wireless access terminal and a wireless interface, and the at least one electronic device further comprising software configured to receive an electronic superbill and automatically send related charges to a third party provider for payment.

Joao discloses a central processing computer, provider computer, and payer computer being capable of transmitting information over a wireless communication network or system (col. 14 line 48 to col. 15 line 58), wherein the provider computer generates a claim form for submission to at least one of a healthcare payer and a healthcare insurer (col. 43 lines 30-55).

At the time the invention was made, it would have been obvious to combine the features of Joao within the system of Pritchard and Aleia with the motivation of reducing the costs of processing treatment claims and/or claims for healthcare services and/or benefits by performing claims processing electronically (Joao; col. 2 lines 1-12).

In addition, as per the recitation of an "electronic superbill", it is noted that Joao's recitation of a "claim form" is considered to be a form of an "electronic superbill". Further, it is noted that a "superbill" is a commonly used method of recording patient care information in a form.

### ***Response to Arguments***

11. Applicant's arguments with respect to claims 39 and 42-61 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied prior art teaches a medical insurance verification and processing system (4,491,725), methods and apparatus for funding future liability of uncertain cost (4,722,055), health care payment adjudication and review system (5,359,509), medical network management system and process (5,471,382), integrated bill consolidation, payment aggregation, and settlement system (5,978,780), method and computerized system for managing insurance receivable accounts (5,991,733), techniques for estimating charges of delivering healthcare services (6,061,657), method for managing disposition of delinquent accounts (6,456,983), medium recording with accounting support program for dental clinic (JP 2001052059A), medical fee collecting amount (JP 2000076326A), techniques for estimating charges of delivering healthcare services (PCT/US99/02676), integrated



insurance system and method (EP 0935208A2), risk adjustment for a children's capitation rate (Newhouse), 20 secrets of negotiating managed care contracts (Managed care week), the cost effectiveness of HIV prevention from a managed care perspective (Pinkerton), Trauma services: A profit center? (Taheri), Medicare physician referral patents (Shea), and What is your practice Worth? (Poppel).

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (703) 305-

3981. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (703) 305-9588.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 306-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**15. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
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**Or faxed to:**

(703) 872-9306 or (703) 872-9326 [Official communications]

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(703) 872-9327 [After Final communications labeled "Box AF"]


(703) 746-8374 [Informal/ Draft communications, labeled  
"PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,  
Arlington, VA, 7th Floor (Receptionist).

CB

CB

August 18, 2004

  
JOSEPH THOMAS  
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